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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,800	03/15/2004	William M. Terry	W0508.001	1916
37771	7590	11/29/2007		
John Nielsen RANDICK O'DEA & TOOLIATOS, LLP 5000 HOPYARD ROAD, SUITE 400 PLEASANTON, CA 94588			EXAMINER MORGAN JR, JACK HOSMER	
			ART UNIT 3782	PAPER NUMBER
			MAIL DATE 11/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,800

Applicant(s)

TERRY, WILLIAM M.

Examiner

Jack H. Morgan

Art Unit

3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9,10,14,19,20 and 22-33 is/are pending in the application.
- 4a) Of the above claim(s) 25-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9,10,14,19,20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1, 3-6, 9, 10, 14, 19, 20 and 22-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 3 set forth the limitation that the pouch is "elliptically shaped". This term is not defined in the specification, and examiner notes that the pouch as shown in the figures is not an ellipse due to the cut off sections of the pouch, and further the non-symmetrical nature of the pouch as shown.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 3-6, 9, 10, 14, 19, 20 and 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "elliptically shaped" as set forth in claims 1 and 3 is not definite, as it is unclear what "elliptically" means. The applicants figures show a pouch which has a rounded appearance and cut

off sides. Examiner takes the position that any rounded shape, ranging from a circle to an oval with cut off sides meets applicant's claimed limitations of "elliptically shaped."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3 and 5 are rejected under 35 U.S.C 102(b) as being anticipated by Anderson (US 5,451,108). Anderson discloses an elliptically shaped pouch (Fig 1 has an elliptical shape, insofar as applicants claims define the term, note also figure 2 for the cross section being elliptically shape) having a first opening in one end (13), a second, smaller opening in the opposite end (14) where the pouch is shaped so the width near the middle is wider than the width at either of the end openings, said pouch being round in shape, and elongated, further being composed of cotton fabric (Col 2, line 43), meeting the applicants claimed limitation of "cloth".

4. Claims 1, 3, 5, 19, 20, 22, 23 and 24 are rejected under 35 U.S.C 102(b) as being anticipated by Geller (US 3,322,176). Geller discloses an elliptically shaped

pouch (Fig 2, note elliptical cross sectional area parallel to opening 3) having a first opening in one end (3), a second, smaller opening in the opposite end (8) where the pouch is shaped so the width near the middle is wider than the width at either of the end openings, said pouch being round in shape, and elongated, further being composed of cotton fabric (Col 1, line 45), meeting the applicants claimed limitation of "cloth". Geller further discloses the pouch having a means for grasping for carrying comprising a handle (2) attached for carrying, said handle being a loop, which could alternatively be seen as a hole, allowing the pouch to be hung on a peg or dowel.

5. Claims 1, 3, 4 and 5 are rejected under 35 U.S.C 102(b) as being anticipated by Nevitt (US 3,150,640). Nevitt discloses an elliptically shaped pouch (Fig 1-3, note elliptical cross section at 28) having a first opening in one end (60), a second opening in the opposite end (30, 38), where the first and second openings are different sizes, the first having a larger diameter than the second, and further where the pouch is shaped so the width near the middle is wider than the width at either of the end openings, said pouch being round in shape, and elongated, further being composed of woven fabric (Col 3, lines 54-58), meeting the applicants claimed limitation of "cloth". Further, Nevitt discloses a zipper (Fig 2, 82) running longitudinally allowing the first opening (60) to be widened for easier insertion of objects into the bag.

6. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Schulman (US 6,190,045). Schulman discloses an elliptically shaped pouch (Fig 1, note cross

sectional area parallel to openings) having a first opening in one end (26), where the pouch is shaped so the width near the middle is wider than the width at either of the ends.

7. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al. (US 6,085,695). Miller et al. disclose an elliptically shaped pouch (Fig 2, note cross sectional area parallel to openings) having a first opening in one end (11), where the pouch is shaped so the width near the middle is wider than the width at either of the ends.

8. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Blauer (US 2,880,422). Blauer discloses an elliptically shaped pouch (Fig 1, note cross sectional area of opening) having a first opening in one end (14), where the pouch is shaped so the width near the middle is wider than the width at either of the ends.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (US 5,451,108). Anderson discloses all the limitations of the claims except for

a closing mechanism at each of the open ends, said mechanism comprising a drawstring. Anderson does however disclose the top opening (13) having a drawstring (15) in order to more easily fill the pouch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a drawstring closure to the second opening in order to more easily fill and empty the from the second opening, since such a modification would amount to a mere duplication of parts. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (US 5,451,108) in view of Revels et al. (US 6,353,215). Anderson discloses all the limitations of the claims except for the pouch being made of flexible polyurethane, instead disclosing a pouch made of plastic film (Col 2, line 4). Revels et al. discloses a pouch made out of polyurethane, in order to provide a moisture impermeable pouch (Col 2, lines 34-36). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to create the pouch of Anderson out of moisture impermeable polyurethane as taught by Revels et al. in order to make a waterproof pouch.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (US 5,451,108) in view of Lyman (US 4,988,216). Anderson discloses all the limitations of the claims except for the pouch being closed at each end using flaps, said flaps being held shut using hook and loop material. Lyman discloses an elongate pouch

(Fig 1, 2) having an opening (13), which has a flap (28) to close it, and said flap is held in the closed position, with hook and loop material (32 and 34) in order securely close the pouch and prevent items from falling out. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to create the pouch of Anderson with the flap with hook and loop closures at each end in order to securely close the pouch and prevent items from falling out.

12. Claims 1, 3, 19, 20, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirtz (US 4,688,674) in view of Anderson (US 5,451,108). Stirtz discloses an elliptical (note cross sectional shape) cord holding pouch having a first opening (30) at one end of the pouch, and a second, smaller opening (22) at the other end of the pouch, wherein the pouch is round and elongated in shape. Stirtz further disclosing a handle (36) to assist in carrying the pouch, capable of hanging the pouch from a nail, peg or dowel, as the handle comprises a loop. However, Stirtz does not disclose the middle of the pouch being wider than the width at either of the end openings. Anderson discloses a pouch having a wider middle than ends, which allows the pouch to hold more, as well as provide a more controlled release of the materials held inside. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to create the cord holding pouch of Stirtz with the wider middle section as taught by Anderson in order to carry a greater volume of material inside the pouch, while still controlling the speed of release of said material.

Response to Arguments

13. Applicant's arguments filed September 26, 2007 have been fully considered but they are not persuasive. Applicant argues that the cited references are not elliptically shaped. As noted above, the pouches round cross sectional areas mean they are elliptically shaped, as circles are a subset of ellipses.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims

"define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack H. Morgan whose telephone number is 571-272-3385. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jack H Morgan
Examiner
Art Unit 3782


NATHAN J. NEWHOUSE
SUPERVISORY PATENT EXAMINER